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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/849,686	08/21/1997	ARNE HELGE DEGGERDAL	08269/003001	4163

7590 08/26/2004  
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EXAMINER

OWENS JR, HOWARD V

ART UNIT PAPER NUMBER

1623

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

08/849,686

**Applicant(s)**

DEGGERDAL ET AL.

**Examiner**

Howard V Owens

**Art Unit**

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5-17,19-25 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-17,19-25 and 27-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### ***Response to Arguments***

The following is in response to the amendment filed 1/20/04:

An action on the merits of claims 1,5-17, 19-25 and 27-34 is contained herein below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### **35 U.S.C. 103**

Applicant's arguments filed have been fully considered but they are not persuasive. The rejection of claims 1,5-17, 19-25 and 27-34 under 35 U.S.C. 103(a) over Hawkins, U.S. Patent No. 5,898,071 is maintained for the reasons of record.

Hawkins teaches a method of isolating DNA from a sample in the absence of any chaotropic agent via binding of the nucleic acid to a magnetic polymer bead in the presence of the detergent SDS, wherein the use of magnetic beads obviates the need for centrifugation. Hawkins also teaches the subsequent separation of the sample from the bound support through wash steps with a buffer, as well as the packaging of this process in a kit (columns 8-9). Hawkins does not teach the use of oligo dT beads in the DNA separation composition; however, the use of oligo dT beads to bind RNA as an adjunct method in nucleic acid separation was commonly known in the art (see applicant's admission on p.3 of spec., last paragraph). Admitted prior art can be used in obviousness rejections. *In re Nomiya*, 509 F.2d 566, 184 USPQ 607, \*611< (CCPA).

It would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to use a detergent and magnetic polymer to isolate genomic DNA.

A person of ordinary skill in the art would have been motivated to separate genomic DNA from RNA using a magnetic particle given the prior art teaching

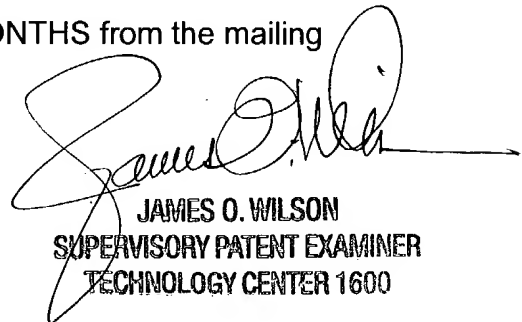
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that fast and efficient removal of DNA is afforded from nucleic acid samples via the use of functionalized magnetic particles.

Applicant's primary argument is that the teachings of Hawkins do not target the removal of genomic DNA with a magnetic polymer, citing col.4, lines 42-47, wherein plasmid DNA is cited for isolation. However, applicant's have targeted an alternative embodiment of Hawkins teachings wherein the reference as a whole is not limited to the isolation of only plasmid DNA with the polymer detergent composition. Hawkins clearly teaches in col, 4, lines 32-36, "A solution containing DNA's can be any aqueous solution, such as a solution containing DNA, RNA and/or PNAs. Such a solution can also contain other components such as other biomolecules, inorganic compounds and organic compounds". Thus it is clear that the isolation of DNA with a polymer is not limited to plasmid DNA.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



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